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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,002	09/05/2003	Steven A. Reesc	044182 / 305880	7517
7590	09/26/2007			
Pillsbury Winthrop LLP Intellectual Property Group Suite 200 11682 El Camino Real. San Diego, CA 92130-2092			EXAMINER BOECKMANN, JASON J	
			ART UNIT 3752	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/656,002	REESE ET AL.	
	Examiner Jason J. Boeckmann	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10/12/2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/19/2007 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Precision stage of claims 1, 9, 10, 11 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "412" appears to represent three different parts in figures 4A- 4B. In figure 4A, reference number appears to be pointing to some sort of elongated clamp or stopper. In figure 4B, reference number 412 appears to be referencing a group of cylinders used to keep the viewing sample in place. Lastly, in figure 4C, reference number 412 appears to be referring to two rods. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 23, it is unclear how a window can correspond to a travel range. Is the range of travel of the precision stage limited by the boundaries of the window, or, does the window lie inside the range of travel of the precision stage?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 9-11, 13-15, 17 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagener et al. (4,262,991).

Wagener et al. shows a precision travel staging system comprising a precision stage (1), a fixed portion (9) configured to be attached to the precision stage, a movable portion (3) operatively coupled to the fixed portion (9) and selectively movable relative

thereto, a securing mechanism (6, 7 and the object holder, not shown, column 2, line 6) configured to secure a substrate at a predetermined location relative to the moving portion (3) and an actuator mechanism (5,8) operative to provide movement of the movable portion (1) in one direction relative to the fixed portion, said movement being operative to position a selected area of the substrate within a precision travel range of the precision stage.

With respect to claims 5-7 and 13-15, the staging system further includes an indexed reference system (shown on the movable precision stage 1, not labeled). The reference system comprises a pointer (shown on the precision stage 1, not labeled) and a plurality of reference indicia (shown on the precision stage 1, not labeled).

Regarding claims 10 and 11, the fixed portion (9) is integrated with the precision stage (1), and the fixed position of the fixed portion is selectively alterable to the fixed position.

In use of the device of Wagner et al., the methods and steps of claims 17 and 19-22 are inherently performed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 8, 16, 18 and 23, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagener et al. (4,262,991) in view of Den Engelse et al. (5,900,708).

Regarding claims 4, 12 and 23, as best understood, Wagener et al. shows all aspects of the applicant's invention as in claims 1 and 9, but does not specifically disclose that the movable portion (3) comprises a aperture that cooperates with the aperture of the fixed portion (figure 1) to form a window in the holder. However, Den Engelse et al. shows a substrate holder comprising a movable portion (44) including a securing mechanism (48 and 50), the movable portion including an aperture (42). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to substitute the movable portion of Den Engelse et al.'s invention, including the securing mechanism and the aperture (42), for the movable portion (3) of the substrate holder of Wagner et al., in order to strengthen the overall device as well as allow for light to shine through the substrate.

Regarding claims 8 and 16, Wagener et al. shows all aspects of the applicant's invention as in claims 1 and 9, but does not specifically disclose that the actuator mechanism is a motor. However, Den Engelse et al. shows a substrate holder comprising actuator mechanism comprising a motor (34, 36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to

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include the actuator mechanism comprising a motor (34, 36) of Den Engelse et al. in order to make the movable portion (1) move automatically.

Regarding claim 18, in the use of the device of Wagener et al. all the steps and methods of claim 17 are inherently preformed except for the securing mechanism including a spring biased element. However, Den Engelse et al. shows a substrate holder comprising a securing mechanism (50) that utilizes a spring biased element. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to substitute the securing mechanism (50) of Den Engelse et al. for the securing mechanism (not shown) of Wagener et al. in order to better secure the substrate to the movable stage (3) without the need for tools.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new interpretation of the Wagner et al. reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Boeckmann whose telephone number is (571) 272-2708. The examiner can normally be reached on 7:30 - 5:00 m-f, first Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJB JPB 9/18/07



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